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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/660,527      | 09/12/2003  | Tetsuro Motoyama     | 241499US2CONT       | 5289             |

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EXAMINER

PRIETO, BEATRIZ

ART UNIT PAPER NUMBER

2142

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/660,527

Applicant(s)

MOTOYAMA ET AL.

Examiner

Prieto B.

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### ***DETAILED ACTION***

1. This communication is in response to Amendment filed 05/08/06, claims 1-3, 5-7, 9-11, have been amended, claims 1-16 remain pending. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 08, 2006 has been entered.

2. Information Disclosure Statement (IDS) under 37 CFR 1.97 filed 10/26/05 & 05/08/06, comprising a list of applicant's pending application(s), published application(s) or issued patent(s) which may be related to the present application, has been considered, initialed and enclosed accordingly.

### ***Double Patenting Rejection***

3. Quotation of non-statutory double patenting rejection based on a judicially created doctrine may be found in previous office action.

4. Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of US 5,544,289 (referred to as patent '289 hereafter) in view of Barrett et. al. (US 5,935,262). Although the conflicting claims are not identical, they are not patentably distinct from each other because instant application is an obvious variation of the '289 patent.

Regarding claim 1, Motoyama teaches obtaining over the network by a first remote device which is the first remote device to obtain device information from the image handling device (claim 1 of the '289 patent claims transmitting semi-static data from a business office device to a computer, where the business office device is a copier/printer see claims 4/6 of the '289 patent respectively, receiving the semi-static state data to the remote computer see claim 7 of the '289 patent),

the device information including status information obtained from the image handling at device (see claim 7 of the '289 for receiving the semi-static state data at the remote computer), and a device identification of the image handling device (see claims 14 of the '289 patent claims receiving a model identification of the business office device and see claim 15 of the '289 patent claims receiving serial number of the business office device); however claims do not explicitly disclose where transmitted status

information is obtained from sensors of the handling device and stored on the remote computer, processed to generate information and transmitting to a second computer.

Barrett teaches transmitting status information from a image handling device over the network to a first remote computer (col 1/lines 20-65), transmitting status information from the first remote computer to a second computer (col 5/lines 20-38), status information includes data that changes during the life of the image handling device (col 6/lines 31-45) including status information obtained from sensors (e.g. detector or counters) (col 1/lines 44-50) and processing the stored (col 1/lines 51-55) device information by the first monitoring device or second monitoring device to generate a information based on the status information obtained over a period of time (col 11/lines 28-col 12/line 5, processing formatting obtained information to generate report, col 16/lines 25-40, col 12/lines 28-38). Barrett teaches the transmission of log file information based on a predetermined condition including inter alia when a predetermined time has been met, thereby periodically transmitting information to a computer (col 2/lines 1 1-26), the information including status information (col 25/lines 47-55), the processing and formatting in response to said predetermined condition obtained status information to generate report (Fig. 29 and col 35/lines 16-50).

It would have been obvious to one ordinary skilled in the art at the time the invention to periodically process and format status information for transmission to a computer by the device itself or by a computer as discussed by Barrett enabling the periodic transmission of status information base on predetermined condition such as when sufficient information is available or a memory capacity has been met, upon demand or in response to a predetermined time being met, set forth by Barrett.

***Claim Rejection under 35 U.S.C. 103***

5. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

6. Claims 1-3, 5-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mil (US 5,282,127) in view of Sekizawa (US 6,430,711).

Regarding claims 1, 5 and 9, Mil teaches an image-handling device (1) communicatively coupled to a network (6) (col 4/lines 20-29 and 45-58), the method comprising;

receiving over the network (6) by a first remote device (4), which is the first remote device to obtain device information from the image-handling device (1) (col 4/lines 22-29, 37-44, 45-58),

the device information including status information obtained from sensors (7) of the image handling at device (col 4/lines 59-col 5/line 5, col 6/lines 14-24), and a identification of the image-handling device (col 14/lines 36-42);

storing in storage means (234/232) of the first monitoring device (col 5/line 57-col 6/line 9), the obtained device information (col 10/lines 42-49, 56-65, storing received information col 15/lines 11-20);

processing by processing means (233) the stored device information by the first monitoring device to generate information (period usage report) is based on the status information obtained over a predetermined period of time (col 11/line 9-29, information including usage information col 12/line 60-col 13/line 5, obtained over time col 13/lines 27-37, usage information at a predetermined time, col 13/lines 46-51, and usage over a period of time col 13/lines 52-57), information includes usage information (col 14/lines 22-35, including identification of the image handling device col 14/lines 36-42);

processing by processing means includes generating usage information (col 15/lines 57-col 16/line 34); although Mil teaches obtaining by a device which is the first to obtain device information from a plurality of image handling devices over a network, it does not explicitly teach transmitting said information to a second device and where the network is particularly the Internet.

Sekizawa teaches receiving by a second device over a network information transmitted from a first device in obtaining over a network device information from an image-handling device. Specifically,

receiving by a second device (20) transmitting information over a network (6) from a first monitoring device (10) in receiving device information from a image-handling device (P) over a network (3) (col 2/lines 63-col 3/line 10, 14-18, 25-43, Fig. 1, col 18/lines 45-col 19/line 14);

receiving by the second device transmitted information including status information about the image handling device and storing in storage means said information (col 6/lines 36-48);

status information includes status information obtained by sensing means for sensing operational condition of the image handling device, e.g. remain amount information of the toner remaining amount, the ink remaining amount from the corresponding, i.e. identified printer (col 20/lines 51-57), where status information is obtained over a period of time (col 4/lines 32-50);

generating information (period usage report) status log (12) based on the status information obtained over a period of time (col 21/lines 9-20, 50-57, col 28/lines 44-67);

transmitted information to the second device includes device identifier and status information about the image-handling device (col 30/lines 24-35) and

where the network is the Internet, specifically, where *every type of computer network can be adopted as the second-type computer network, i.e. Internet (6) so long as the computer network provides terminal-to-terminal information transfer service through electronic mail and connects LANs (e.g. LANs*

3a-3c) (column 19, lines 1-6). One would be motivated to apply the suggestions of Sekizawa for obtaining by a first monitoring computer over the Internet and the communication between the first monitoring computer and the second monitoring computer is over the Internet, because in doing so the communication costs can be more decreased as compared with the conventional system using a facsimile machine, etc., because the Internet covers almost all the world. Since the Internet eliminates local problems, the integrated monitor unit can be installed anywhere. Thus, the state of each of the machines installed in various areas can be monitored in batch at one or several sites; the number of persons required for monitoring the machine state can be decreased and service can be improved, as suggested by Sekizawa.

It would have further been obvious to one of ordinary skill in the art at the time the invention was made given the suggestion of Mil for monitoring image handling devices coupled to a network, the teachings of Sekizawa for remotely monitoring over a network a plurality of image handling devices coupled to a local network would be readily apparent. One would be motivated in combining the above mentioned teachings which would transmission of the usage report over the network from the first monitoring device in the Mil system to a second monitoring device receiving the usage report by the second monitoring device as taught in the Sekizawa system, reducing the cost of communication as stated by the latter. One would be motivated to combine these teachings for determining based on the usage information when the image handling device require maintenance as noted by Sekizawa when discussing prior art because in doing so maintenance service may be dispatched efficiently to said device regardless of the number of device via described network low cost configuration for monitoring a number of image handling devices in a wide area range distributed in several remote sites, as disclosed by Sekizawa.

Regarding claim 2, transmitting the usage report to the second monitoring device, at a predetermined time or upon the occurrence of a predetermined event (Sekizawa: col 4/lines 44-51).

Regarding claim 3, wherein the image-handling device is a copier (Mil, Fig. 1), and the usage report includes a number of copies made by the copier over the predetermined period (Mil: col 4/lines 59-col 5/line 5 and col 6/lines 14-24).

Regarding claims 6-7, these system claims are substantially the same as the method claims 2-3, discussed above, same rationale of rejection is applicable.

Regarding claims 10-11, these computer program product claims are substantially the same as the method claims 2-3 and the system claims 6-7, discussed above, same rationale of rejection is applicable.

7. Claims 4, 8 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mil in view of Sekizawa in further view Danknick et. al. U.S. Patent No. 5,901,286 (Danknick hereafter)

Regarding claims 4, 8 and 12, however the above-mentioned reference(s) does not teach the use of HTML or Excel formats in its usage reports;

Danknick discloses as prior art accessing a network device by a computer to obtain the network device's status information including converting the obtained status information to an HTML format (col 1/lines 45-48), furthermore teaching relocatable software executing on a computer configured to translate information regarding status information associated with usage in a network device into a HTML format for rendering as a web page (col 10/lines 30-36) or other formats (col 12/lines 42-48).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the teachings of Hashimoto for monitoring a network device by accessing its status information a including displaying the obtained data received via modem telephone based network to include supporting the access to network device status information via a telephone network, motivation would be to further enhance Hashimoto's system with existing technology such as high speed digital lines, e.g. high speed integrated digital network (ISDN) telephone lines enabling Web based monitoring functions as set forth by Danknick.

Regarding claims 13-15, report is generated on a monthly or weekly basis (Sekizawa: weekly, monthly or daily basis col 9/lines 45-57, Mil: col 10/lines 23-32).

Regarding claim 16, the method of claim 1, of monitoring an image handling device communicatively coupled to the Internet, obtaining by a first monitoring device over the Internet and the communication between the first monitoring computer and the second monitoring computer is over the Internet, further where the second monitoring computer and the image handling device communicative coupled to the Internet are arranged in a same local area network (Sekizawa: Fig. 1).

### *Response to Arguments*

8. Applicant argues (p. 8 of remarks) regarding non-statutory double patenting rejection based on a judicially created doctrine that claim 1 of the '289 patent fails to disclose (i) obtaining by a first monitoring status information from sensors of an image handling device. However, claim 1 of the '289 patent claims transmitting semi-static data from a business office device to a computer, where the business office device is a copier/printer (claims 4/6 of the '289 patent respectively), receiving the semi-static state data to the remote computer (claim 7 of the '289 patent), semi-static data is data of the copier that changes frequently; (ii) obtaining identification of an image handling device.

However, it is respectfully noted that claims 14 of the '289 patent claims receiving a model identification of the business office device and claim 15 of the '289 patent claims receiving serial number of the business office device and (iii) storing device information by the first monitoring device to generate a usage report of the image handling device, wherein the period usage report is based on the status information obtained over a predetermined period of time (Barrett; processing the stored device information by the first monitoring device or second monitoring device to generate a information based on the status information obtained over a period of time see col 11/lines 28-col 12/line 5. Barrett teaches the transmission of log file information based on a predetermined condition including inter alia when a predetermined time has been met, thereby periodically transmitting information to a computer see col 2/lines 1 1-26, the information including status information see col 25/lines 47-55, the processing and formatting in response to said predetermined condition obtained status information to generate report see Fig. 29 and col 35/lines 16-50).

9. Regarding claim 1 rejected under 35 USC 101 as being unpatentable over Barrett, it is argued the applied prior art fails to teach claim limitation as amended. Specifically, obtaining by a first monitoring device over the Internet and the communication between the first monitoring computer and the second monitoring computer is over the Internet.

In response to the above-mentioned argument, applicant's interpretation of the applied prior art has been fully considered. However the image handling devices in the Barrett patent are configured to transmit electronic messages over the Internet. Specifically, the image handling device's interface is configured with multiple protocol stack (col 9/lines 1-3), namely, Internet Protocol (IP) based communication protocols, such as Novell's IPX/SPX protocol stack (col 9/lines 4-12) and TCP/IP protocol stack (col 9/lines 26-32). Barrett illustrates on Fig. 1 a collection of networks (LANs 100, 110, 120) including a collection of local area networks and a wide area network (col 2/lines 60-61) coupled via a device that connects networks (e.g. 130) passing information from one to the other, the communication



over the networks uses the TCP/IP suite of protocols to communicate with one another. Thus, the Barrett's illustrated system does seem to exclude what is defined as the "Internet" to one of ordinary skill in the art at the time the Invention was made.

Thereby, Barrett discloses obtaining by a first computer over the Internet, and further where the device information of at least one network device, and the device information including status information. The computer used to access the log file is the first computer to obtain the device information from the at least one network device (column 1, lines 51-65). The status information operational parameters and the like (column 1, lines 35-36), information related to image forming jobs received and the output to the image forming apparatus, statistical information related to the operation of the network device and/or status information and usage information for generating bills for the use of the network device, its maintenance or re-supply of resources used therein or diagnosing information (column 1, lines 40-50).

10. Regarding claim 1 rejected under 35 USC 103 as being unpatentable over Mil in view of Sekizawa, it is argued (p. 9 of remarks) the applied prior art fails to teach claim limitation as amended. Specifically, obtaining by a first monitoring device over the Internet and the communication between the first monitoring computer and the second monitoring computer is over the Internet because the according to Applicant in the Barrett reference the Integration of NED hardware, software and firmware with a peripheral eliminates the need to dedicate a network personal computer to act as a peripheral server.

In response to the above-mentioned argument, applicant's interpretation of the applied reference has been considered. In this case, the alleged integration of NED hardware, software and firmware with a peripheral eliminates the need to dedicate a network personal computer to act as a peripheral server seem to configure the printer 'image handling device' to communicate over the Internet. Specifically, Barrett discloses that image handling device's interface is configured with multiple protocol stack (col 9/lines 1-3), namely, Internet Protocol (IP) based communication protocols, such as Novell's IPX/SPX protocol stack (col 9/lines 4-12) and TCP/IP protocol stack (col 9/lines 26-32).

11. Regarding claim 1 rejected under 35 USC 103 as being unpatentable over Mil in view of Sekizawa, it is argued (p. 10 of remarks) the applied prior art fails to teach claim limitation as amended. Specifically, obtaining by a first monitoring device "computer" over the Internet and the communication between the first monitoring computer and the second monitoring computer is over the Internet because Mill communicates over a telephone line, leased line or LAN and Sekizawa communicated over a local area network.

In response to the above-mentioned arguments, applicant's interpretation of the applied art has been considered. In this case, according to Sekizawa, the first device "computer" is connected to the first-type computer network together with the machines to be monitored gets the status information of the machines to be monitored and transmits the status information to the second device "computer" (col 3/lines 14-19). Specifically, Sekizawa teaches where: The computer 10 is connected to a first-type computer network, a LAN (local area network), 3 (3a-3c) of three LANs 3 are shown of the same configuration; the LAN 3a connects a plurality of network printers P, an agent unit 10, and a router 4 to each other; the router 4 connects the LAN 3a to a second-type computer network 6 set so as to cover a wider area (second-type area) 5 than the first-type area 2. In the embodiment, the Internet covering almost all the world is adopted as the second-type computer network 6. *However, every type of computer network can be adopted as the second-type computer network 6 so long as the computer network provides terminal-to-terminal information transfer service through electronic mail and connects LANs.* (column 19, lines 1-6). In a second embodiment of the invention specifies that the first-type computer network in the first embodiment is a local area network and the second-type computer network is the Internet. If the Internet is thus adopted, the communication costs can be more decreased as compared with the conventional system using a facsimile machine, etc., because the Internet covers almost all the world. Since the Internet eliminates local problems, the integrated monitor unit can be installed anywhere. Thus, the state of each of the machines installed in various areas can be monitored in batch at one or several sites; the number of persons required for monitoring the machine state can be decreased and service can be improved (col 3/lines 50-col 4/line 5).

Thus, Sekizawa suggests where *every type of computer network can be adopted as the second-type computer network, i.e. Internet (6) so long as the computer network provides terminal-to-terminal information transfer service through electronic mail and connects LANs (e.g. LANs 3a-3c)* (column 19, lines 1-6). One would be motivated to apply the suggestions of Sekizawa for obtaining by a first monitoring computer over the Internet and the communication between the first monitoring computer and the second monitoring computer is over the Internet, because in doing so the communication costs can be more decreased as compared with the conventional system using a facsimile machine, etc., because the Internet covers almost all the world. Since the Internet eliminates local problems, the integrated monitor unit can be installed anywhere. Thus, the state of each of the machines installed in various areas can be monitored in batch at one or several sites; the number of persons required for monitoring the machine state can be decreased and service can be improved, as suggested by Sekizawa.

Thus, arguments that the applied reference(s) fail to teach claim limitation as now amended, specifically, obtaining by a first monitoring computer over the Internet and the

communication between the first monitoring computer and the second monitoring computer is over the Internet has been considered but not found persuasive.

12. Applicant's arguments filed in the response indicated above have been fully considered but not found persuasive.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

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May 23, 2006

  
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